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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/858,145	05/14/2001	Daniel Prohaska	501009.01	2191
27076 7590 04/19/2007 DORSEY & WHITNEY LLP INTELLECTUAL PROPERTY DEPARTMENT SUITE 3400 1420 FIFTH AVENUE SEATTLE, WA 98101			EXAMINER CARLSON, JEFFREY D	
			ART UNIT	PAPER NUMBER
			3622	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		04/19/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

09/858,145

Applicant(s)

PROHASKA ET AL.

Examiner

Jeffrey D. Carlson

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3,5,6,11-21 and 24-77 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5,6,11-21 and 24-77 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**1. Claims 68-77 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

- Claims 68-69 simply set forth three documents. The content of the documents sets forth agreements between different parties, yet these agreement documents are taken to be nothing more than data per se and represent non-functional descriptive material. Claims 70-77 are rejected for similar reasons even though they appear to set forth content on computer media. In essence, these claims are an electronic equivalent of the problematic agreement documents. These claims are taken to represent documentation of a series of agreements and information useful for implementing the disclosed system, yet there is no apparatus programmed with the capabilities of carrying out the functionalities. See MPEP 2106 IV B 1 b.

### ***Claim Rejections - 35 USC § 103***

**2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:**

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**3. Claims 1-3, 5, 6, 11-21 and 24-77 are rejected under 35 U.S.C. 103(a) as being unpatentable over “traditional business model” (applicant admitted prior art).**

Applicant provided prior art disclosure as a traditional business model in paragraphs 0004-0005 of the published instant application (US PG Pub 20020023030). In this applicant-admitted prior art, a client retains an attorney for legal services, the attorney refers the client to an asset manager for providing of financial assistance/benefits to the client. Applicant describes that the attorney in most jurisdictions is prevented from receiving fees from the benefit provider or from the client for making the referral. *Inasmuch as pertinent, Examiner notes that the instant invention appears to go against this regulation in that the claimed invention appears to facilitate what amounts to a referral fee from the benefit provider to the attorney. Nonetheless, the challenges presented by current regulatory hurdles in practicing business will not be taken into consideration by the examiner, nor will any success in overcoming or sidestepping such regulation provide a patentable distinction. Rather, the claims will be evaluated for novelty and obviousness with respect to the technology of the present field of endeavor.*

Regarding claim 1, the claim (and others with similar language) is interpreted to provide the following positive limitations: a method for a first entity servicing a second entity, a referred third entity servicing the second entity, the second entity paying the

third entity and the third entity providing compensation to the first entity. Language describing the types or qualities of the entities and language describing why acts are performed do not positively set forth or limit any particular method *steps* that are carried out and are therefore not taken to limit the claims. The traditional business model provides the three entities and the services, but not necessarily transfer of funds from the third entity to the first. However, applicant admits that referral fees are known, but are against regulation in most (i.e. not all) jurisdictions. It would have been obvious to one of ordinary skill at the time of the invention for the *desire* to send a referral fee from 3 to 1, yet to designate any such compensation as other than a referral fee given the illegalities of such. Therefore it would have been obvious to one of ordinary skill at the time of the invention to have provided funds/value from 3 to 1 in the form of a gift or a dinner or an amount of money without calling it a referral fee. It would have been obvious to one of ordinary skill at the time of the invention to have called such a payment as payment in consideration for the 1<sup>st</sup> service entity<sup>1</sup> provides to entity<sup>2</sup>. Regarding applicant's language that the compensation "from fees entity<sup>3</sup> charges entity<sup>2</sup>", it would have been obvious to one of ordinary skill at the time of the invention to have paid the compensation using funds earned from any number of sources, including fees from entity<sup>2</sup>. Depositing entity<sup>2</sup>'s money into an account and then paying entity<sup>1</sup> a compensation from this account is taken to read on the claim language of "from fees the third entity charges the second entity". Further, it would have been obvious to one of ordinary skill at the time of the invention for entity<sup>2</sup> to pay entity<sup>3</sup> with the notion that entity<sup>3</sup> pass along at least some of the funds to entity<sup>1</sup> for the service

provided by entity1. In many cases, these referring businesses may be good friends, relatives, or work in the same building and entity2 may find it easier to simply pay entity3 with the notion that some of the funds should be disbursed to entity1 for his efforts. Official Notice is taken that it is common for a person owing several people money to pay the entire sum to one of them with instructions for them to disburse funds to the other deserving recipients. It would have been obvious to one of ordinary skill at the time of the invention to have done so with such a "traditional business model" of attorney and financial consultant for example. Further still it would have been obvious to one of ordinary skill at the time of the invention for entity3 to provide funds from his earnings to entity1 in the situation where entity2 fails to pay entity1 whatsoever. Entity3 may feel it is the right thing to do to at least partially compensate entity1 for his efforts, especially where entity3 has indeed been fairly paid. It would have been obvious to one of ordinary skill at the time of the invention to have made these payments to preserve the goodwill and integrity of the entity1-entity3 relationship or simply because entity3 feels morally compelled to see entity1 gets paid.

Regarding claims 2, 3, 5, 6, 11-21, 37-50, 54, the wide variety of services claimed by applicant are all well known services to provide to a client by way of different service providers. It would have been obvious to pay a compensation between any two types of service providers.

Regarding claims 24-26, 51-53, applicant admits that periodic payments and proportional value payment schemes are known. It would have been obvious to one of

ordinary skill at the time of the invention to have used these with the traditional business model.

Regarding claims 27, 33, 60, it would have been obvious to one of ordinary skill at the time of the invention that any entity can make referrals and/or other payments to any other entity for business purposes.

Regarding claims 28-31, 55-58, 65-67 applicant admits that different entities can enter into affiliated memberships and it would have been obvious to one of ordinary skill at the time of the invention that the entities involved form affiliated relationships so that they can provide team-based servicing. It would have been obvious to one of ordinary skill at the time of the invention that team members provide instructional materials to their clients in order to assist them in understanding the services.

Regarding claims 32, 34, 35, 59, 61, 62, 76, 77, Official Notice is taken that entities that are affiliated in business frequently exchange business information over the Internet by way of remote access to computer systems and by email exchange. It would have been obvious to one of ordinary skill at the time of the invention to have accessed and/or transmitted the business information involved in the proposed business arrangement and services over a network for convenience in order to enable remotely located clients and service entities to conduct business electronically.

Regarding claim 36, 63, a condition cannot limit a method claim. Either the method steps are performed or not. Optional steps or limitations regarding other alternative scenarios do not form part of the performed method steps.

Regarding claim 64, Official Notice is taken that a retiring attorney transfers his clients to another attorney. It would have been obvious to one of ordinary skill at the time of the invention to have transferred the client to another entity when the attorney leaves the affiliated membership or stops practicing law so that the client can continue to receive the needed service.

Regarding claims 68-75, Official Notice is taken that it is well known to draft contracts for business agreements and it would have been obvious to one of ordinary skill at the time of the invention to have documented (on paper and/or electronically) not only the proposed business arrangements between the involved entities and the fees they would pay and receive, but also the assets involved and the details of the services provided as they are rendered.

### ***Response to Arguments***

Applicant argues that the claims require a lack of referral fees. Examiner has described how the prior art renders obvious payments from entity3 to entity1 in two ways. The first is in place of a referral fee where rules do not permit and the second is where entity3 is paid for all services and entity3 distributes funds to entity1.

### ***Conclusion***

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).




A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Mon-Fri 8a-5:30p, (work from home on Thursdays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jeffrey D. Carlson  
Primary Examiner  
Art Unit 3622

jdc